

Appl. No. 09/918,223
Atty. Docket No. 7496RC
Amtd. dated June 10, 2004
Reply to Office Action of March 15, 2004
Customer No. 27752

REMARKS

Claims 2 – 5, 10 – 13, and 15 – 19 are pending in the present application. Claims 4, 5, 10 and 17 – 19 have been rejected under 35 USC § 103(a). Claims 2, 3, 11 – 13, 15 and 16 have been objected to but would stand allowed if rewritten in independent form.

Rejection Under 35 USC § 103(a) Over Homebest Premium Baby Wipes

Claims 4, 5, 10 and 17 – 19 have been rejected under 35 USC § 103(a) as being unpatentable over Homebest Premium Baby Wipes (Homebest). Applicants respectfully traverse this rejection as the Office Action has not made out a proper *prima facie* case of obviousness with regard to Claim 17.

To establish a case of *prima facie* obviousness, there must be a suggestion or motivation, either in the reference itself or in the knowledge generally known to one of ordinary skill in the art, to modify the reference. Secondly, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all of the claim limitations. The Office has not established a *prima facie* case of obviousness because at a minimum there is no showing of a suggestion or motivation to modify the Homebest reference in the prior art itself.

The Office Action puts forth the argument that it would have been obvious for one of ordinary skill in the art to experiment with the ingredients of the prior art and length of the first panel. A conclusion of obvious to experiment without any additional showing is insufficient to establish obviousness. *In re Dow Chemical Co.*, 837 F.2d 469 (Fed. Cir. 1988). An improper conclusion of obvious to experiment exists when a general disclosure may pique a scientist's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result or indicate that the claimed result would be obtained if certain directions were pursued. *In re Eli Lilly & Co.*, 902 F.2d 943 (Fed. Cir 1990).

Claim 17 is directed to specific combinations of lotion ingredients and wipe sizes to impact dispensing reliability. There is no showing in the Office Action of a recognition or an appreciation in the prior art that the combination of wipe size in cooperation with the composition of the lotion would have any relationship to the dispensing performance of the wipes. There has been no showing that Homebest recognized a need for better reliability in dispensing at all, much less that the combination of wipe size and lotion ingredients in the ranges claimed affects, much less delivers, such improved reliability. Further, the Office Action has not shown that one of ordinary skill in the art would have made the decision to experiment with the

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composition of the lotion and the size of the wipes in order to change the dispensing performance. The Office has assumed a recognition of the need for better dispensing performance existed at the time of the Homebest invention and the impact of the claimed parameters in combination on such performance.

The Homebest reference does not provide any guidance how or why to modify the combination of ingredients with size of baby wipe in order to create a more reliable dispensing system. Therefore a proper *prima facie* case of obviousness has not been made with regard to Claim 17. All of the remaining claims depend from Claim 17 and are patentable over Homebest for at least the reasons stated above.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 USC § 103(a). Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 2 – 5, 10 – 13 and 15 – 19.

Respectfully submitted,

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